

documents into a single printable document, as recited by amended Claim 1. Therefore, is the outstanding rejection of Claim 1, and other similar independent claims still proper?

Status of the claims

Claims 1-24 and 26-38 are pending in the application. Claims 1, 16, 17, and 29 have been amended more particularly to point out and distinctly claim the present invention. Claims 1, 16, 27, 28, 29, 31, and 38 are independent.

Requested action

Applicants respectfully request the Office to reconsider and withdraw the outstanding rejections in view of the foregoing amendment and the following remarks.

Rejection

In the Advisory Action the Examiner maintains the rejection of the independent claims over the patent to Judson in view of the patent to Yoda.

Response to rejection

In response, while not conceding the propriety of the rejection, independent Claims 1, 16, 27, and 29 have been amended. Applicants submit that amended independent Claims 1, 16, 17, and 19 and independent Claims 28, 31, and 38 are allowable over this art for the following reasons.

A. Independent Claim 1

1. Claim 1 explains how a single, printable hyper-text-containing document is formed via a formatting step, which step is not disclosed or suggested in either the Yoda or Judson patents.

Independent Claim 1 relates to a method of forming a printable document by collating a plurality of hyper-text documents. The method comprises the steps of monitoring a user's access patterns to the hyper-text documents, accessing the hyper-text documents including structure information of the accessed hyper-text documents, compiling a list of the hyper-text documents using the structure information, and formatting the list into the printable document comprising each hyper-text document specified in the list.

Independent Claim 1 has been amended to recite that the method relates to a method of forming a single printable document. Claim 1 has also been amended to recite that the accessing of the hyper-text document is performed from monitoring a user's access patterns to the hyper-text document. Claim 1 has been further amended to recite that the list that is compiled is of the accessed hyper-text documents. Finally, Claim 1 has been amended to recite that the printable document into which the list is formatted comprises each hyper-text document selected from the list.

This arrangement permits the formation of a single printable document comprising hyper-text documents selected from a list of user-accessed hyper-text documents compiled from monitoring a user's access patterns to the hyper-text documents. Thus, the user's mere browsing of a computer network can be used to identify (i.e., form a list) hitherto unrelated documents and form a single printable document comprising selected hyper-text documents from that list. These listed hyper-text documents may be sourced from within a homepage, and thus include their own internal linking or may be entirely disparate, as can

be seen from the print list 61 of Figure 5, the corresponding functions of which are described at page 7, line 26 through page 8, line 21 of the specification.

In summary, Claim 1 explains how a single printable document, comprising selected hyper-text documents, is formed (e.g., by monitoring a user's hyper-text-document access patterns, accessing the monitored documents, compiling a list of the accessed documents using the document structure information, and formatting the list into a printable document).

2. The Yoda patent teaches how to print information two-way linked to a base document once the base document is specified, but fails to disclose how the base document is formed, for example, via Claim 1's formatting step.

The Yoda patent does not discuss how its printable documents are formed. Rather, this patent merely states that once a base document, already containing hyper-text links, is selected by the user, the printer 18 prints all information linked to the base document in two ways (columns 5 and 6 of the Yoda patent). For example, column 6, lines 47-53 state:

As described above, according to the present invention, when a plurality of pieces of document information which are linked to each other to have given document information as a base document are simultaneously printed out, document information which is linked to the base document information in two ways is specified, and only this specified information is printed.

Thus, this patent does not discuss how the base document, with its links, is formed. And this patent certainly does not disclose or suggest that the base document is formed by compiling links by monitoring a user's access patterns. Therefore, this patent does not

disclose or suggest the concept of forming a single printable document comprising hyper-text documents selected from a list of user-accessed hyper-text documents compiled from monitoring a user's access patterns to the hyper-text documents, as recited by amended Claim 1.

2. The Judson patent merely teaches storing a user's web-browsing history and the printing of associated information objects, rather than the formatting of a list of user-accessed hyper-text documents into a single, printable hyper-text containing document, as recited by amended Claim 1.

The Judson patent relates to browser application that saves the history of accessed documents, stores those documents in a cache memory, and stores information objects placed within a comment tag of a web page. These information objects, which can be "advertisements, messages, fill-in forms, notices from a service provider, notices from another Internet service provider (such as receipt of an e-mail message), or some third party notice" (column 2, lines 1-4), are not displayed with the web page, but are saved in cache. They are displayed during the downtime that occurs between linking and downloading, the next time an associated web page is linked and downloaded. The information objects can also be automatically or selectively queued to a printer upon display of an associated web page, as discussed at column 7, lines 46-50. This activity gives the user material to read while waiting for a web page to download. But printing an information object upon displaying a web page is not the forming of a single printable document comprising hyper-text documents selected from a list of user-accessed hyper-text documents compiled from monitoring a user's access patterns to the hyper-text documents, as recited by amended Claim 1.

3. The cited art's lack of the formatting step of Claim 1 prevents the Office from establishing a prima facie case of obviousness under MPEP § 2142.

MPEP §2142 provides three criteria that must be satisfied to establish a prima facie case of obviousness. First, there must be some suggestion or motivation to combine the art. Second, there must be some reasonable expectation of success. And third:

To establish a prima facie case of obviousness... the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Here, as noted above, each cited patent fails to disclose or suggest the step of formatting a list into a single, printable document comprising hyper-text documents selected from a list of user-accessed hyper-text documents compiled from monitoring a user's access patterns to the hyper-text documents, as recited by amended Claim 1. Therefore, MPEP § 2142 mandates the allowance of amended Claim 1 over the patents to Judson and Yoda.

The Office Action only asserts that the first criteria has been met. It does not address the second or third criteria. Since the Office Action does not establish that each of these criteria have been satisfied, it has not established a prima facie case of obviousness.

4. The Office has failed to satisfy its burden of proof under MPEP § 2142 because it has provided no evidence of record making it more probable than not that the skilled artisan would combine the art to produce Claim 1's formatting step.

MPEP § 2142 places the burden of proof on the Office to establish a prima facie case of obviousness by providing "evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of

obviousness) is more probable than not.” (MPEP Original Seventh Edition, Revision 1, February 2000, page 2100-97, right column, lines 13-17.)

Here, the Office Action postulates that it would be obvious to use the Judson patent’s concept of storing the user’s browsing history to create the Yoda patent’s base document. Presumably, this combination of features would permit the forming of a single printable document comprising hyper-text documents selected from a list of user-accessed hyper-text documents compiled from monitoring a user’s access patterns to the hyper-text documents, by formatting the list, as recited by amended Claim 1. Therefore, MPEP § 2142 requires the Office to establish *by evidence of record* that the skilled artisan would be more likely than not to combine the browser-history-storing feature of the Judson and the linked-document printing feature of the Yoda patent to produce the method of amended Claim 1.

But there is no such evidence of record suggesting the use of the browser history, as taught in the Judson patent, in a patent such as the Yoda patent, to format a list of user-accessed hyper-text documents into a single printable document. Without such evidence, the Office has not established by a preponderance of the evidence that the skilled artisan would be more likely than not to combine the art to produce the method of amended Claim 1.

So, what do the final rejection and the advisory action cite as *evidence* establishing that it is more probable than not that the skilled artisan would use the browser history, as taught in the Judson patent, to format such a list into a printable document? Merely the observation at page 5 of the final rejection and on page 2 of the advisory action that the objective of the Yoda patent is to “print a hypermedia document in a format that a user can easily understand” (column 2, lines 50 and 51). But the Office misquotes the Yoda patent.

Column 2, lines 50 and 51 state that the object of the Yoda patent is to print a hypermedia document in a format that “a user can easily use”. And the Yoda patent makes clear from the paragraphs before and after this quote that what he means by ease of use is 1) automatically inhibiting certain information from being printed twice (which can occur when printing all links to and from a document) and 2) automatically assigning serial page numbers to printed, linked documents (which prevents pages from being printed out of order when non-linearly linked and stored documents on a network are printed). Thus, the Yoda patent teaches that it is desirable to prevent duplicate printing of information and to print non-linearly stored data in a certain linear order. And neither feature is necessarily achieved by forming Yoda’s base document by using the browser-history feature of the Judson patent. Thus, this statement is the Yoda patent does not establish that the skilled artisan would be more likely than not to combine the Yoda and Judson patents to produce the Claim 1 invention.

Moreover, it is not clear that the skilled artisan would even look to the Judson patent to achieve objectives 1) and 2) because these two patents are directed to completely different network subject areas and solve completely different problems. This is because the Judson patent is directed to a method of making the web-page loading time tolerable by displaying or printing object information related to a web site while the user waits for the web site to be downloaded (column 1), while the Yoda patent is directed to avoiding problems associated with the linear management of printed documents when documents are linked to each other in a non-linear manner (columns 1 and 2).

Accordingly, the citation of the Yoda and Judson patents does not establish that the skilled artisan would be more likely than not to form a single printable document

comprising hyper-text documents selected from a list of user-accessed hyper-text documents compiled from monitoring a user's access patterns, as recited by amended Claim 1. As a result, the Office has not satisfied its burden of proof to establish a prima facie case of obviousness against amended Claim 1 under MPEP § 2142.

5. MPEP § 2143.01 prohibits the Office from rejecting Claim 1 over the Yoda and Judson patents.

Since the references do not suggest the desirability of formatting a list into a single printable document, as recited by amended Claim 1, the Office can only argue that the reference teachings should be combined to produce such a step because they can. But this reasoning is expressly prohibited by MPEP §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (MPEP Original Seventh Edition, Revision 1, February 2000, page 2100-98, right column, lines 36-38).

6. Conclusion

Since the cited art fails to disclose or suggest the formatting step of amended Claim 1, and since the cited art fails to provide evidence that the skilled artisan would be more likely than not to combine the references to produce such a step, the Office has not satisfied two of the three criteria of MPEP § 2142. Accordingly, the Office has not satisfied its burden of proof to establish a prima facie case of obviousness. Thus, the Office's argument becomes: Claim 1 is obvious because the references can be combined to produce the Claim 1 invention. But this reasoning is prohibited by MPEP § 2143.01. Therefore, amended independent Claim 1 is allowable over the patents to Yoda and Judson.

B. Independent Claim 16, 27, 28, 29, 31, and 38

Although independent Claims 16, 27, 28, 29, 31, and 38 are directed to different inventions than amended Claim 1, they recite similar features and are allowable for similar reasons.

Thus, the Judson and Yoda patents do not disclose or suggest a method of forming a single printable document by collating a plurality of hyper-text documents comprising the step of collating and formatting accessed hyper-text documents using structure information and at least a predetermined printable document format to form a printable document in which the accessed hyper-text documents are contiguously arranged therein over at least one printable page, as recited by amended Claim 16.

The Judson and Yoda patents, therefore, also do not disclose or suggest a computer implemented method for forming a single printable document by collating a plurality of documents obtained from a plurality of sources comprising the step of collating selected documents according to a predetermined order of collating to form a printable document, the collating comprising arranging at least one display page according to a size of each selected document based upon corresponding structure information wherein the printable document is reproducible by at least by printing, as recited by amended Claim 27.

Consequently, the Judson and Yoda patents do not disclose or suggest means for monitoring access to documents via a resource locator and compiling a list of accessed ones of the documents, the list including corresponding links and structure information pertaining to each accessed document, and means for collating the list into a selected order

and for formatting the accessed documents within the list into a single printable document having at least components corresponding to the accessed documents arranged in the selected order, as recited by Claim 28.

Thus, the Judson and Yoda patents do not disclose or suggest a computer readable medium including instruction modules comprising a collating module for collating user selective ones of documents from a compiled list into a single printable document in which each selected document is formatted according to structure information derived from monitoring browsing operations and a printing module for causing a printing of the single printable document thereby causing hard copy reproduction of the single printable document and the selected documents, as recited by amended Claim 29.

As a result, the Judson and Yoda patents do not disclose or suggest a computer program product having a computer readable medium having a computer program recorded thereon for forming a printable document by collating a plurality of hyper-text documents, comprising means for compiling a list of selected ones of the hyper-text documents using structure information of the documents and means for formatting the list into a printable document comprising the selected ones of the accessed hyper-text documents, as recited by Claim 31.

Finally, the Judson and Yoda patents do not disclose or suggest a computer implemented program for forming a single printable document by collating a plurality of hyper-text document, the method comprising the steps of fetching hyper-text documents accessed by a first application including corresponding structure information thereof and creating a single formatted printable document version of the accessed hyper-text documents, as recited by independent Claim 38.

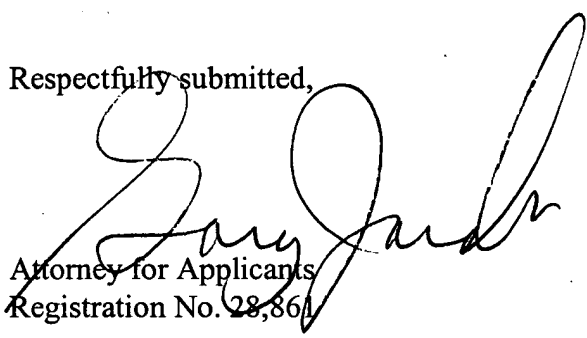
The dependent claims are allowable for the reasons given with respect to the independent claims and because they recite features which are patentable in their own right. Individual consideration of the dependent claims is respectfully solicited.

The other art of record is also not understood to disclose or suggest the inventive concept of the present invention as defined by the claims.

In view of the above amendments and remarks, the claims are now in allowable form and entry of this amendment is considered proper. Therefore, early passage to issue is respectfully solicited.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

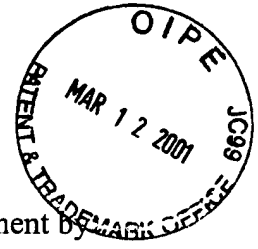
Respectfully submitted,



Attorney for Applicants
Registration No. 28,861

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile No.: (212) 218-2200

MARKED-UP AMENDED CLAIMS



1. (Twice Amended) A method of forming a single printable document by collating a plurality of hyper-text documents, said method comprising the steps of:

- (a) monitoring a user's access patterns to the hyper-text documents;
- (b) from said monitoring, accessing the hyper-text documents including structure information of the accessed hyper-text documents;
- (c) compiling a list of the accessed hyper-text documents using the structure information; and
- (d) formatting the list into the printable document comprising each hyper-text document selected from [specified in] the list.

16. (Amended) A method of forming a single printable document by collating a plurality of hyper-text documents, said method comprising steps of:

- (a) accessing the hyper-text documents including corresponding structure information;
- (b) collating and formatting the accessed hyper-text documents using the structure information and at least a predetermined printable document format to form the printable document in which the accessed hyper-text documents are contiguously arranged therein over at least one printable page thereof.

24. (Unamended) A method as claimed in Claim 16, further comprising the step of displaying the printable document in preview form while the user accesses the hyper-text documents.

27. (Twice Amended) A computer implemented method for forming a single printable document by collating a plurality of documents obtained from a plurality of sources, said method comprising the steps of:

monitoring accesses to documents in sequence;

recording the contents of a plurality of selected ones of the documents including structure information relating to each selected document; and

collating the selected documents according to a predetermined order of collation to form the printable document, said collating comprising arranging at least one display page according to a size of each selected document based upon the corresponding structure information, wherein the printable document is reproducible at least by printing.

29. (Twice Amended) A computer readable medium including instruction modules arranged to collate for printing a single document a plurality of documents derived from a plurality of sources in a network, said modules comprising:

a monitoring module for monitoring browsing operations throughout the network;

a compiling module for compiling a list of selected documents encountered during the browsing operations;

a collating module for collating user selected ones of the documents from the list into a single printable document in which each selected document is formatted according to structure information derived during the monitoring; and

a printing module for causing a printing of the single printable document thereby causing hard copy reproduction of the single printable document and the selected documents.